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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,400	01/28/2004	Jun Miyajima	00862.023442	2547
5514	7590	12/12/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			SEVERSON, JEREMY R	
			ART UNIT	PAPER NUMBER
			3653	

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/765,400

Applicant(s)

MIYAJIMA, JUN

Examiner

Jeremy R. Severson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/28/04, 3/25/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because its length exceeds 150 words. Correction is required. See MPEP § 608.01(b).

Claim Objections

2. Claims 1-12 are objected to because of the following informalities: the language used is confusing because the language "stor[ing] predetermined information on a paper sheet" appears to mean that the information is physically stored on the sheet, e.g., printed on a sheet. Using a word such as "about" instead of "on" would correct this confusing language. Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 9-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Applicant is claiming a "computer program product."
5. "Functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. This type of "descriptive material" is nonstatutory when claimed as descriptive material per se, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally

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interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. See MPEP 2106.01.

6. In this case, "computer program product" is broad enough language to encompass nonstatutory subject matter, as it could encompass, e.g., a signal or carrier wave.

7. Claim 13 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 13 is nominally a method claim, however, there are no method steps positively set forth in the claim. The claim merely states that the paper feed destination is not automatically changed.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dei (4,763,889) in view of Yaginuma (US 5,848,320).

10. Re claim 1, Dei discloses an image forming apparatus having a plurality of paper feed portions capable of setting index sheets, comprising: a storage section (4-6) which stores predetermined information on a paper sheet set in each paper feed portion; and a control section (16) which performs processing of automatically changing the paper

feed portion between the plurality of paper feed portions on the basis of the predetermined information stored in said storage section, wherein when pieces of predetermined information on the sheets set in the paper feed portions coincide with each other, said control section controls the paper feed portions so as to perform change processing between the plurality of paper feed portions in which sheets are set, and when the pieces of predetermined information do not coincide with each other, controls the paper feed portions so as not to perform change processing (col. 5, lines 17-35). Dei does not explicitly address the use of index sheets in the paper feed portions. However, Yaginuma teaches the use of tab sensors (130a-130e) for detecting a size and position of the tabs (Yaginuma, col. 7, first par.). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add tab sensors to Dei, and perform the automatic cassette changing of Dei based on the output of the tab sensors, as taught by Yaginuma, for detecting a size and position of the tabs.

11. Re claim 2, the apparatus of Dei as modified by Yaginuma comprises the apparatus according to claim 1, wherein the predetermined information stored in said storage section includes information on a size and a type of the paper sheet set in the paper feed portion (Dei, col. 2, lines 51-54), and when the paper type is an index sheet, information on the number of index portions and/or a shape of the index portion is further stored (Yaginuma, col. 7, lines 31-33).

12. Re claim 3, the apparatus of Dei as modified by Yaginuma comprises the apparatus according to claim 2, further comprising an index sheet setting section which

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sets the information on the number of index portions and/or the shape of the index portion (Yaginuma, col. 7, lines 31-33).

13. Re claims 4-8, the apparatus of Dei as modified by Yaginuma comprises the apparatus according to claim 1, wherein the image forming apparatus further comprises a paper feed portion change setting section which sets whether to automatically enable paper feed portion change processing for each of the plurality of paper feed portions, and when said paper feed portion change setting section performs a setting which permits paper feed portion change processing for the paper feed portions in which the index sheets are set, but the pieces of predetermined information on the index sheets set in the plurality of paper feed portions are determined not to coincide with each other, said control section controls the paper feed portions so as not to perform change processing. See Dei, cols. 3 and 4.

14. Re claim 9, the apparatus of Dei as modified by Yaginuma comprises a computer program product (16) which stores a control program for causing a computer to execute control of an image forming apparatus having a plurality of paper feed portions capable of setting index sheets, wherein the program has a code for a storage step of storing predetermined information on a paper sheet set in each paper feed portion, and a code for a control step of performing processing of automatically changing the paper feed portion between the plurality of paper feed portions on the basis of the predetermined information stored in the storage step, and in the control step, when index sheets are set in the plurality of paper feed portions and pieces of predetermined information on the index sheets set in the paper feed portions coincide with each other, the paper feed

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portions are so controlled as to perform change processing between the plurality of paper feed portions in which index sheets are set, and when the pieces of predetermined information do not coincide with each other, the paper feed portions are so controlled as not to perform change processing. See Dei, cols. 3 and 4.

15. Re claim 10, the apparatus of Dei as modified by Yaginuma comprises the product according to claim 9, wherein the predetermined information stored in the storage step includes information on a size and a type of the paper sheet set in the paper feed portion, and when the paper type is an index sheet, information on the number of index portions and/or a shape of the index portion is further stored (Yaginuma, col. 7, lines 31-33).

16. Re claim 11, the apparatus of Dei as modified by Yaginuma comprises the product according to claim 10, further comprising an index sheet setting step of setting the information on the number of index portions and/or the shape of the index portion (Yaginuma, col. 7, lines 31-33).

17. Re claim 12, the apparatus of Dei as modified by Yaginuma comprises the product according to claim 9, wherein the computer program product further comprises a paper feed portion change setting step of setting whether to automatically enable paper feed portion change processing for each of the plurality of paper feed portions, and when a setting which permits paper feed portion change processing for the paper feed portions in which the index sheets are set is performed in the paper feed portion change setting step, but the pieces of predetermined information on the index sheets set in the plurality of paper feed portions are determined not to coincide with each other,

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the paper feed portions are controlled in the control step so as not to perform change processing. See Dei, cols. 3 and 4.

18. Re claim 13, the apparatus of Dei as modified by Yaginuma comprises a method of controlling an image forming apparatus having a plurality of paper feed portions capable of setting index sheets, wherein when the numbers of index portions and/or shapes of the index portions of index sheets set in the plurality of paper feed portions do not coincide with each other, a paper feed destination is not automatically changed from a paper feed portion subjected to paper feed to another paper feed portion. See Dei, col. 4, lines 47-53.

Conclusion

Any prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Severson whose telephone number is (571) 272-2209. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey, can be reached at 571-272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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